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EXAMINER

LEE, BENJAMIN C

ART UNIT	PAPER NUMBER
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2632

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,377

Applicant(s)

TURNER, PAULETTE BERNETTA

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input checked="" type="checkbox"/> Other: <u>Appendix</u> |

DETAILED ACTION

Drawings

1. The drawings were received on 8/13/04. These drawings are not accepted by the Examiner due to introduction of new matter: They are structurally different from those originally filed on 6/26/03.

Specification

2. The substitute specification filed 8/13/04 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: it does not include a statement of no new matter, and it does not include a separate copy showing markups of the changes. See Appendix below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 22-30 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

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For examples:

1) In claim 22:

a) claim should end with a period since a claim needs to be in a single sentence form;

b) line 1: it is unclear which constitutes a “personal persona voice medical responder” or a “non-personal personal voice medical responder”; i.e. it should be clarified as either personal or non-personal;

c) limitation of the preamble (lines 1-4) of the claim, i.e. the claimed “voice medical responder watch” and “highly intensified signal alarm” limitations, were never included or linked in the body of the claim, thus such limitation may not need to be considered as part of the claimed subject matter;

d) lines 5 and 9, “scrap” seemed to should have meant --strap--;

e) line 9, “said wrist” lacks antecedent basis;

f) line 11, “the compartment, peripheral side surfaces” lacks antecedent basis;

g) lines 15-16, “the outer area” and “the inner area” were not defined;

h) lines 17-18, “the on/off button” appearances lack antecedent basis.

2) In claim 23:

a) lines 1-4, “as in claim 22” suggests that claim 22 recites everything (e.g. “warning system”) the preamble of claim 23, but claim 22 in actuality does not (e.g. “warning system”);

b) line 5, “allowing” should have been --comprising--;

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c) line 9, "taping of endless minutes" is unsupported since no such technology currently exists;

d) lines 10-11, "said message" lacks antecedent basis from a previous "messages";

e) line 13, "a personal response voice message warning system.." appears to should have been --wherein said personal response voice message warning system.. -- since the term already has antecedence; "will house" is indefinite since it suggests the housing feature is sometime in the future but not necessarily now or any particular time in the future;

f) lines 17-18, it is unclear how a system that allows the second party to respond by playback method to the first party is in the form of "a detection system" which implies some type of "detection";

g) line 20, "the electronic alarm circuit" lacks antecedent basis;

h) line 21, "an speaker" should read --a speaker--;

i) claim should end with a period on line 21.

3) In claim 24:

a) lines 1-2 of the preamble, "further allowing as in claim 22" implies that the claim 22 itself allows the features in the body of claim 24, while in actuality claim 24 has everything in claim 22, but additionally or more specifically includes the limitations recited in the body of claim 24;

b) line 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d);

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c) line 7, the claims should end with a period.

4) In claim 25:

a) line 2, “can be” is indefinite since what follows is not positively recited/included;

b) claim should end with a period.

5) Claim 26:

a) “said personal response voice message warning system” lacks antecedent basis from claim 22;

b) lines 1-4, it is grammatically unclear here, since “housing a power supply for” suggests that the following sections a.-g. are being enabled or as a result of the power supply, however, lines 3-4, for example, recites “battery powered, and or housing a battery powered recharging unit comprising an element for plugging into an electrical circuit”, which in itself is unclear (e.g. “battery powered” what, is not specified; after “an or”, “housing a battery powered recharging unit” read in light of the preceding portion “housing a power supply for” does not make grammatical sense here);

c) lines 4 and 9, “comprising” should read --comprising--;

d) lines 13-14, it is unclear how “any environmental condition unit” can be fitted on a watch since some are too bulky, for example;

e) line 14, it is noted that “optional” renders the smoke detector or environmental condition unit unnecessary and therefore need be considered in the prior art;

f) line 14, “the housing case member” lacks antecedent basis;

g) line 17, claim should end with a period.

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6) Claim 27, “lettering unit..” was not described in claim 22, and claim should end with a period.

7) Claim 28:

a) line 2, preamble should end with --comprising--, or --for--, etc.

b) line 2, “the” should have been --a--;

c) lines 6-7, how is “personal pre-recordings” related to the antecedences of “messages” should be defined, and “the housing unit” lacks antecedent basis;

d) claim should end with a period.

8) Claim 29:

a) line 2, “compromising” appears to should have been --comprising--;

b) lines 1-2, “For...comprising” has no subject, so it is unclear what method or apparatus is being claimed;

c) line 7, “the devices” lacks antecedent basis; “will” is indefinite;

d) line 19, “will be” is indefinite;

e) line 21, it is unclear how “electrical powered with an emergency light” would “allowing it to be waterproof”.

9) Claim 30: “smoke detector mechanism” is not supported in claim 22; in “optional to units” it is unclear what is optional, and which units; furthermore, it is noted that “optional” renders the claimed limitation(s) unnecessary when considered against prior art.

NOTE

6. Due to the number of issues as exemplified in the above 35 USC 112 second paragraph rejection, it is noted here that the Examiner has given the claim language the most reasonable interpretation possible in the following prior art consideration in order to expedite prosecution of this application. New matter consideration for the new claims 22-30 will be given in a future Office action when a proper substitute specification with markup copy has been received in the Office for proper comparison. An Appendix has been included at the end of this Office action to provide Applicant with guidance on a proper response to this Office action.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (US 5864288).

1) Regarding claim 28, Hogan discloses the claimed speaker unit (414) connected to device unit (Figs. 1 & 4) being able to record and playback for transmittal of messages from a first to a second party (col. 3, lines 39-43); for playback through means of a random access memory (RAM 425) for storing digitized messages (col. 5, lines 35-46) to house a digital sound generator (audio chip 413) by receiving and converting personalized-recorded messages into an analog signal and provide said signal to loudspeaker (414 and col. 5, lines 43-46) for retrieving

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personal pre-recordings in a digitized unit (col. 5, lines 43-46 and col. 6, lines 53-59) inside the housing unit (Figs. 1 and 4).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeOme (US 20004/0155781) in view of Kita (US 5852401) and Gibson et al. (US 6614357).

1) Regarding claim 22:

a) DeOme discloses a person monitoring and security device having the claimed security watch (24) having a strap to be worn around a person's lower arm in a watch like fashion and the ability to be hand carried, portable, inserted, affixed to, in, on or around or near one's persons or anything of attachment to housing (Figs 1 & 3 and [0030]); having a housing unit with a circular, flat unit attached to the wrist strap with a visible front plate, a solid back plate with an area for battery accessibility and battery source member inside the compartment, and peripheral side surfaces, a watch like face covering supporting the housing unit and displaying time in a waterproof, fire resistant and see through fashion (conventional or inherent features on a watch using electricity as referenced by watch 24), ability to connect a sound passageway from the outer area to the inner area (inherent from speaker 120 in Fig. 3 as part of watch 24), an actual connecting button for the switching of the on/off button to the unit (obvious on any device

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requiring electrical power such as watch 24), an actual connecting button for the electronic switching of the on/off button for a highly intensified audible alarm panic/warning siren (panic button 125 of [0030] in lieu of [0039]);

While:

b) Kita discloses a security watch 10 (Fig. 2) specifying watch like face covering supporting the housing unit and displaying time of day, month, date and year with switch buttons (Fig. 2 and col. 3, lines 7-19; col. 4, lines 9-16);

c) Gibson et al. teaches the known recording of voice messages on a watch by a first party for playback of a prerecorded voice by a second party using switches (Abstract, Fig. 4G and disclosure) using digitized unit (use of processor 14, etc.) and having a water resistant housing (col. 4, lines 43-46) to provide security against incapacitation or situations where a person is unable to respond (Abstract).

In view of the teachings by DeOme, Kita and Gibson et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a watch like face covering supporting the housing unit and displaying time of day, month, date and year as taught by Kita in a watch of DeOme to show month, date and year information in addition to time for more specific time referencing, and furthermore to include a known voice message record/playback feature as taught by Gibson et al. in DeOme and Kita to provide the security against incapacitation or situations where a person is unable to respond so that personal security is enhanced by such addition/inclusion.

2) Regarding claim 23, DeOme, Kita and Gibson et al. render all of the claimed subject matter obvious as in claim 22, including:

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a) the claimed 2 audible alarms; one being alterable (voice recording that is re-recordable in Gibson et al.) and one is unalterable (panic alarm);

b) claimed speaker (120 of DeOme, 12 and col. 2, line 51 of Gibson et al.);

c) claimed transmitter and receiver (131, 123 of DeOme);

d) claimed microphone (16 and col. 2, line 54 of Gibson et al.);

e) claimed panic device button and siren button have been met in claim 22;

f) claimed detection system to allow the second party to respond by playback method to the first party is met by the playback button and function considered in claim 22;

g) claimed listening speaker device (120 of DeOme, 16 of Gibson et al.).

3) Regarding claim 24, DeOme, Kita and Gibson et al. render all of the claimed subject matter obvious as in claim 22, whereby:

--the claimed voice messages being erasable and played continuously or repeatedly are met by the re-recordable and multiple-playback ability of the Gibson et al. features.

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeOme in view of Gibson et al.

1) Regarding claim 25, DeOme and Gibson et al. render all of the claimed subject matter obvious as in the consideration of claims 22-23 (without the unnecessary date/year detail of Kita), including:

a) the claimed first input device (said microphone);

b) claimed main processor (130 of DeOme; 14 of Gibson et al.);

c) claimed main database (127 of DeOme; 10 of Gibson et al.);

d) claimed main output device (said speaker);

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except:

e) the claimed flashing message counter.

Since flashing message counters for voice record/playback devices such as answering machines have been known in the art for attracting the attention of an intended user to message or messages intended for playback, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include such flashing message counter in DeOme and Gibson et al. for that same reason.

12. Claims 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeOme in view of Kita, Gibson et al. and Thornblad (US 6285289).

1) Regarding claim 26, DeOme, Kita and Gibson et al. render all of the claimed subject matter obvious as in claims 22, wherein:

a) the claimed housing a power supply (watch housing with inherent watch battery in DeOme);

b) claimed housing compartment unit including a cylindrical flat member having front, back surfaces and side peripheral surfaces on the housing ("button battery" inherently used in watch of DeOme);

c) claimed lighted compartment unit for easy visibility and illuminate number and/or text messaging within the housing (known on watches for eliminating display face for easy visibility and therefore obvious in a watch of DeOme);

While Thornblad teaches:

d) claimed a security device in the form of a watch having a silent alarm function and activation button and smoke detector to enhance safety and security of wearer (Abstract).

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In view of the teachings by DeOme, Kita, Gibson et al. and Thornblad, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a known silent alarm function with activation button and smoke detector function as taught by Thornblad in a watch such as taught by DeOme, Kita and Gibson et al. to enhance security and safety of the wearer. Furthermore, since recharging kits having plug and prong connectors as claimed are well known in the art for charging battery powered devices, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a battery recharging kit having plug and prong connectors for charging a battery powered device such as taught by DeOme, Kita, Gibson et al. and Thornblad in order to allow extended use and longer battery life. Additionally, using a lighted compartment unit for easy visibility by illuminating numbers and/or text messaging within the housing are well known on displays such as watches, pagers, cell phones, etc. and is thus obvious in the digital watch device of DeOme, Kita, Gibson et al. and Thornblad for better visibility.

2) Regarding claim 30, DeOme, Kita and Gibson et al. render all of the claimed subject matter obvious as in claims 22, plus the consideration of claim 26 further in view of Thornblad, including:

a) the claimed smoke detector with optical detector member (col. 4, lines 40-45 of Thornblad);

b) claimed recessed button on outer peripheral side of housing (Figs. 5-6 of Thornblad; Fig. 2 of Kita).

13. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeOme in view of Kita, Gibson et al. and Fischer (US 4120039).

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1) Regarding claim 27, DeOme, Kita and Gibson et al. render all of the claimed subject matter obvious as in claims 22, while:

Fischer teaches a known watch having a computer capability (memory, text display, processor, etc.) and text input keys (Abstract and figures).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention that if intended users of a system such as taught by DeOme, Kita and Gibson et al. prefers text messages over voice messages, a text message input and output feature as taught by Fischer implemented in DeOme, Kita and Gibson et al. as a substitute or addition in order to cater to those users without expected results.

14. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Morris (US 6184787).

1) Regarding claim 29, Hogan met all of the claimed subject matter as considered in claim 28, including:

- a) claimed digital processor (420);
- b) claimed button (col. 4, lines 30-31);
- c) claimed allowing device to be waterproof (col. 3, lines 51-52);

while:

Morris teaches in the same art of leaving a recorded message by a first party for playback by a second party (col. 3, lines 27-36) the known use of power failure protection by using backup battery (which inherently includes battery compartments) in addition to AC power supply (col. 4, lines 2-4) which would save stored messages during an electrical power outage.

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In view of the teachings by Hogan and Morris, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a power failure protection feature of Morris in Hogan to provide continued operation even during power outage, wherein the back up battery can be implemented using a well known rechargeable battery to maintain its charge. Furthermore, lighting/illumination for electrical user devices have been well known to allow improved visibility especially during a power outage as anticipated in the Hogan and Morris system, so that the backup powered lighting constitutes emergency lighting for improving visibility of the device.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 5570083, 6724298, 6104292

--Known and similar devices for leaving someone a voice message for playback.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.

Appendix

1. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form may be required. While an application can be amended to make it clearly understandable, no subject matter (new matter) can be added that was not disclosed in the application as originally filed.

2. Following are the copies of § 37 CFR 1.71 (Detailed description and specification of the invention), § 37 CFR 1.75 (Claims), § 37 CFR 1.111 (Reply by applicant or patent owner to a non-final Office action), § 37 CFR 1.112 (Reconsideration before final action), § 37 CFR 1.113 (Final rejection or action), § 1.121 (Manner of making amendments in application); § 37 CFR 1.125 (Substitute specification), and § 37 CFR 1.126 (Numbering of Claims) are provided below regarding the proper format and contents of an application and its amendments:

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to

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such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe”(17 U.S.C. 401) and “*M* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any-one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(f) The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract and sequence listing (if any) should not be included on a sheet including any other part of the application.

[paras. (d) and (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; para. (d), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; para. (f) added, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.75 Claim(s)

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

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(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)

(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,

(2) A phrase such as "wherein the improvement comprises," and

(3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

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(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate physical sheet or electronic page. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

[31 FR 12922, Oct. 4, 1966; 36 FR 12690, July 3, 1971; 37 FR 21995, Oct. 18, 1972; 43 FR 4015, Jan. 31, 1978; para. (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (g) amended, paras. (h) and (i) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (h) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (h) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Director. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

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(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the Examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

[46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or

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without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing

prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this

section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.121 Manner of making amendments in application.

(a) Amendments in applications, other than reissue applications. Amendments

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in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) Specification . Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) Amendment to delete, replace, or add a paragraph . Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and;

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) Amendment by replacement section . If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

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(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification . The specification, other than the claims, may also be amended by submitting::

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) Reinstatement of previously deleted paragraph or section . A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document . Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) Claims . Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

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(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

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(5) Reinstatement of previously canceled claim. A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

(d) Drawings. One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the header, labeled “Replacement Sheet.” Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Marked-up Drawings” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) Disclosure consistency. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) No new matter. No amendment may introduce new matter into the disclosure of an application.

(g) Exception for examiner’s amendments. Changes to the specification, including the claims, of an application made by the Office in an examiner’s amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner’s amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) Amendment sections. Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) Amendments in reissue applications. Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

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(j) Amendments in reexamination proceedings. Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) Amendments in provisional applications. Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.125 Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) Subject to § 1.312, a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is **accompanied by a statement that the substitute specification includes no new matter.**

(c) A substitute specification submitted under this section **must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters.**

The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

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(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(2) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (b) and (c) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

3. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.

4. It has called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. A suggested format for a certificate follows.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 2023 1, on..."

Name of applicant, assignee, or Registered Representative

Signature_____

Date_____

5. The applicant is reminded that copies of U.S. patents have been provided with this Office Action as examples for proper application format.